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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,758	01/04/2002	Fabienne Parker	ST98017 A	4189
5487	7590	01/27/2005	EXAMINER	
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			HELMS, LARRY RONALD	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 01/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/719,758	PARKER ET AL.	
	Examiner	Art Unit	
	Larry R. Helms	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,3,7,8 and 13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 11 has been amended.
2. Claim 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

NOTE: Claim 11 is also withdrawn as being not included in the restriction requirement as directed to non-statutory subject matter (see restriction requirement).

3. Claims 1, 3-4, 7, 8-9, and 13-14 are under examination.
4. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

Claim Objections

5. Claims 13 and 14 are objected to because of the following informalities: The claims should recite "of" after the recited amino acid residues and before "SEQ ID NO:1". Appropriate correction is required.

Response to Arguments

6. The rejection of claims 1, 3, 7, 8, 13 under 35 U.S.C. 112, first paragraph, is maintained.

The response filed 11/22/04 has been carefully considered but is deemed not to be persuasive. The response states that the examiner cites three prior art references

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for the position that not all regions of a protein can be used to elicit apoptotic antibodies and in fact only certain epitopes can and the claimed antibodies do not recognize all regions in the G3BP protein and the claimed antibodies only recognize amino acids 1-144 of SEQ ID NO:1 or even smaller regions. The response further states that the examiner implies that because some antibodies directed to some proteins differ in their ability to induce apoptosis that antibodies directed to G3BP will differ and will require undue experimentation, however, one can expect a reasonable degree of success that antibodies recognizing 1-144 of SEQ ID NO:1 will induce apoptosis (see page 6 of response). In response to this argument, while the claims are directed to any region of 1-144 of SEQ ID NO:144 and specifically 22-55 or 1-72, the specification only teaches that antibodies directed to residues 22-34 of SEQ ID NO:1 induce apoptosis. Claim 1 is directed to any region in 1-144 of SEQ ID NO:1 and claim 3 to any in 1-72 and claim 13, residues 22-55, thus, there are regions that have not been shown to induce apoptosis, specifically only region 22-34 has been shown. Therefore, as the prior art does demonstrate that not all regions of a protein can be used to produce antibodies with apoptosis inducing effects. In fact, the prior art showed that only specific regions in the protein had the ability to induce apoptosis. Even though the response states that one can expect a reasonable degree of success, one skill in the art would not know which regions to select or which amino acids to use to produce antibodies against in order to produce apoptosis antibodies except amino acids 22-34 of SEQ ID NO:1. It would require an undue experimentation for all the combinations of amino acids to use as well as it is unpredictable as demonstrated in the prior art whether an antibody produced to

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just any region would induce apoptosis. Thus, the prior art teaches that not all regions of a protein can be used to elicit apoptotic antibodies and in fact only certain epitopes can. Thus, one skill in the art would not predict that regions outside 22-34 of SEQ ID NO:1 would be capable of producing apoptotic antibodies as evidenced from the prior art that indicated only specific epitopes of the antibodies are capable of inducing apoptosis.

Therefore, in view of the lack of guidance in the specification and in view of the discussion above one of skill in the art would be required to perform undue experimentation in order to practice the claimed invention.

Conclusion

7. Claims 4, 9, are in condition for allowance. Claim 14 is objected to as depending on a rejected claim but would be allowable if rewritten in independent form (i.e. not depending from claim 13 or 3).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.


10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is 703-872-9306.

Respectfully,

Larry R. Helms Ph.D.

571-272-0832

~~LARRY R. HELMS, PH.D.~~
~~PRIMARY EXAMINER~~


LARRY R. HELMS, P.
PRIMARY EXAMINER